

76



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,281	09/26/2003	Hirotooshi Fujisawa	SON-2830	6451
23353 7590 02/07/2007 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER SHAN, APRIL YING	
			ART UNIT	PAPER NUMBER
			2135	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/670,281

Applicant(s)

FUJISAWA, HIROTOSHI

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-18 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. P2002-298292, filed on 11 October 2002 in Japan.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10 and 18 are directed to a computer program product. However, the computer program product is software, per se to one of ordinary skill in the art. There is no element positively recited as part of the computer product in the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2135

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (U.S. Patent No. 6,662,166)

As per **claims 1-4, 9, 11-12 and 17**, Pare, Jr. et al. discloses an information management system/method comprising:

an information management apparatus ("Party Identification Apparatus (PIA)" in fig. 1, 3, 7) for producing an authentication image to be used to authenticate a user ("the payor submits a bid biometric sample obtained from their physical person by the PIA's biometric sensor. The PIA determines that the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC" – e.g. col. 15, lines 26-31), and an information processing terminal ("an integrated LCD screen 14" in fig. 1) for displaying the authentication image provided by the information management apparatus ("information such as the amount of a transaction, the identity of a payee, the list of credit/debit accounts for a payor to select from, or other transaction-related information is displayed using an integrated

Art Unit: 2135

LCD screen 14..." – e.g. col. 8, line 64 – col. 9, line 2. Please note the list of credit/debit accounts for a payor to select from corresponds to Applicant's the authentication image since Pare Jr. et al. discloses in col. 15, lines 35-39, "the DPC identifies the payor, and retrieves the list of credit/debit accounts that the payor has previously registered with the system and then displays on the screen".), wherein the information management apparatus comprises:

generating means for generating a first authentication image based on a predetermined original image ("the payor submits a bid biometric sample obtained from their physical person by the PIA's biometric sensor. The PIA determines that the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC" – e.g. col. 15, lines 26-31),

authenticating means ("Data Processing Center 22" in fig. 4) for authenticating the first authentication image which is provided by the information processing terminal through a control device that controls the reading of an image displayed on the information processing terminal ("...the PIA transmits the biometric or biometric-PIN to the DPC for identification,... The DPC identifies the payor using the biometric sample, and retrieves the lists of credit/debit accounts that the payor has previously registered with the system, and transmits this list back to the PIA..." – e.g. col. 15, lines 32-41), and

display control means for displaying a second authentication image instead of the first authentication image displayed on the information processing terminal

Art Unit: 2135

when the authenticating means verifies that the first authentication image is authentic ("The PIA displays the list of credit/debit accounts to the payor" – e.g. col. 15, lines 42-43 and "information such as the amount of a transaction, the identity of a payee, the list of credit/debit accounts for a payor to select from, or other transaction-related information is displayed using an integrated LCD screen 14..." – e.g. col. 8, line 64 – col. 9, line 2),

wherein the information processing terminal comprises:

acquisition means for acquiring the first authentication image ("the payor submits a bid biometric sample obtained from their physical person by the PIA's biometric sensor. The PIA determines that the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC" – e.g. col. 15, lines 26-31),

second providing means for providing the information management apparatus with the first authentication image, displayed by the display means, through the control device (The DPC identifies the payor using the biometric sample, and retrieves the lists of credit/debit accounts that the payor has previously registered with the system, and transmits this list back to the PIA..." – e.g. col. 15, lines 32-41),

wherein the display means ("an integrated LCD screen 14" in fig. 1) displays the second authentication image instead of the first authentication image when the information management apparatus verifies that the first authentication image provided by the second providing means is authentic ("The PIA displays the list of credit/debit accounts to the payor" – e.g. col. 15, lines 42-43. Please note the list of

Art Unit: 2135

credit/debit accounts for a payor to select from corresponds to Applicant's the authentication image since Pare Jr. et al. discloses in col. 15, lines 35-39, "the DPC identifies the payor, and retrieves the list of credit/debit accounts that the payor has previously registered with the system and then displays on the screen".).

Pare, Jr. et al. does not disclose expressly that first providing means for providing the information processing terminal with the first authentication image generated by the generating means and display means for displaying the first authentication image acquired by the acquisition means. However, Pare, Jr. et al. discloses "information such as the amount of a transaction, the identity of a payee, the list of credit/debit accounts for a payor to select from, or other transaction-related information is displayed using an integrated LCD screen 14..." – e.g. col. 8, line 64 – col. 9, line 2).

It would have been obvious to a person with ordinary skill in the art at the time of the invention that first providing means for providing the information processing terminal with the first authentication image generated by the generating means and first authentication image (the biometric sample) is transaction-related information, which is displayed using an integrated LCD screen 14.

The motivation of doing so would have been to "assure that any biometric input gathered from the biometric sensor is from a real physical person, instead of a copy or replica", as taught by Pare, Jr. et al. (col. 8, lines 15-17) and helps to "determine the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC", as taught by Pare, Jr. et al. (col. 15, lines 28-31)

As per **claim 5**, Pare, Jr. et al. discloses an apparatus as applied above in claim 3. Pare, Jr. et al. further discloses wherein the generating means generates the first authentication image containing first amount information based on a first amount of money already paid by the user (e.g. col. 15, lines 42-61).

As per **claim 6**, Pare, Jr. et al. discloses an information management method as applied above in claim 2. Pare, Jr. et al. further discloses wherein the generating means subtracts an amount spent by the user from the amount represented by the first amount of information when the authenticating means verifies that the first authentication image is authentic, and generates the second authentication image containing a second amount of information based on a resulting remaining amount of money (e.g. col. 15, lines 42-61).

As per **claim 7**, Pare, Jr. et al. discloses an apparatus as applied above in claim 3. Pare, Jr. et al. further discloses wherein the first authentication image and the second authentication image constitute a continuous scene (e.g. col. 8, lines 64-67 and col. 15, lines 42-44. Please note there is no interruption between displaying the first authentication image and the second authentication image. Therefore, they constitute a continuous scene.)

As per **claim 8**, Pare, Jr. et al. discloses an apparatus as applied above in claim 3. Pare, Jr. et al. further discloses wherein each of the first authentication image and

Art Unit: 2135

the second authentication image is one of a still image and a moving image ("biometric sample" – e.g. col. 15, line 26 and "the list of credit/debit accounts" – e.g. col. 15, lines 42-43 are both still images).

As per **claim 10**, Pare, Jr. et al. discloses the claimed method of steps as applied above in claim 9. Therefore, Pare, Jr. et al. discloses the claimed computer product for carrying out the method of steps.

As per **claims 13-14**, Pare, Jr. et al. discloses a terminal as applied above in claim 11. Pare, Jr. et al. further discloses wherein the first authentication image contains a first amount of information based on a first amount of money already paid by the user and wherein the second authentication image contains a second amount of information based on a remaining amount which is obtained by subtracting an amount spent by the user from the amount represented by the first amount of information (e.g. col. 15, lines 42-61).

As per **claim 15**, Pare, Jr. et al. discloses a terminal as applied above in claim 11. Pare, Jr. et al. further discloses wherein the first authentication image and the second authentication image constitute a continuous scene (e.g. col. 8, lines 64-67 and col. 15, lines 42-44. Please note there is no interruption between displaying the first authentication image and the second authentication image. Therefore, they constitute a continuous scene.).

As per **claim 16**, Pare, Jr. et al. discloses a terminal as applied above in claim 11. Pare, Jr. et al. further discloses wherein each of the first authentication image and the second authentication image is one of a still image and a moving image (e.g. col. 15, lines 42-61).

As per **claim 18**, Pare, Jr. et al. discloses the claimed method of steps as applied above in claim 17. Therefore, Pare, Jr. et al. discloses the claimed computer program for carrying out the method of steps.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892)

Art Unit: 2135

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AYS

AYS
5 February 2007


KIM VU

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100